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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,310	08/21/2001	G. David Jang	S63.2-10078	8078

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VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,310

Applicant(s)

JANG, G. DAVID

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,37,42-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,35,37,42-45 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/29/05 + 10/25/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The language requiring a tapered flow path appears to lack antecedent basis from the specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stent with a tapered flow path must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Improper Amendment

The amendment to the claims filed August 29, 2005 was improper because it included therein text of cancelled claims 39 and 40. Since these claims were cancelled by the amendment of December 8, 2004, they cannot be reintroduced with the same claim numbers that have been cancelled. For this reason, these claims have not been considered on their merits, and are considered to be cancelled claims. Applicant is required to provide a proper copy of the claims in any response to this Office action.

Information Disclosure Statement

With regard to the information disclosure statement filed October 25, 2005, only a cursory review of the rather voluminous documents (mostly court proceedings) was made because the documents are not considered particularly directed to the present claims with the particular issues at hand. In particular, the documents appear to relate to claim 36 of the CIP grandparent application now US Patent 5,922,021. Claim 36 does not claim something obvious in view of what is claimed herein so the Examiner did not think that the documents are particularly relevant.

If Applicant believes that more relevant information is contained in these documents, Applicant is hereby requested to explain the particular relevance of the information as they relate to the claimed invention, giving citations of the relevant pages in the documents.

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Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, 42, 43, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US 6,348,065), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US 6,348,065) alone. Brown anticipates the claim language where Brown discloses a stent made from a single piece of material (see column 3, lines 13-17) having ends with different flexibilities than the middle portions (Figure 4 and column 3, line 47 to column 4, line 3). The tapered configuration as claimed along any pair of struts tapering from the point or meeting junction of the pair to the wide or top part of the "V"; see Figure 3 for the stent expanded state which is analogous to the expanded state of Figure 4. The first and second ends of Brown's

stent have different flexibilities as compared to the intermediate segments; see column 3, lines 46-53.

As to the limitation requiring that the stent be cut from a tube, it is the Examiner position that Brown discloses the same structure even though Brown uses a different method of making the same device. In particular, Brown cuts a flat piece of material and then forms the cut material into a tube with welds; see column 2, lines 56-64. This process would result in the same structure as stent cut from a tube as claimed. .

Alternatively, the resulting structure of Brown would be substantially identical to that claimed such that the claimed device would have been considered clearly obvious in view thereof to an ordinary artisan; see MPEP 2113, which is incorporated herein by reference thereto.

Regarding claim 47, no two annular elements are exactly alike due to machine tolerances that inherently result in at least slight differences. For this reason, even the end annular elements would inherently have slightly different flexibilities as compared to each other. For this reason, the claim language is fully met.

Claims 34, 35, 42, 43, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindenberg et al (US 5,716,393), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Lindenberg et al (US 5,716,393) alone. Lindenberg discloses a stent made from a single flat piece of material (see column 3, lines 34-51) having ends with different flexibilities than the middle portions (Figures 2 and 3 as well as and column 3, line 26 to column 4, line 30). The tapered configuration as claimed is at both ends; see Figure 2.

As to the limitation requiring that the stent be cut from a tube, it is the Examiner position that Lindenberg discloses the same structure even though Lindenberg uses a different method of making the same device. In particular, Lindenberg cuts a flat piece of material and then forms the cut material into a tube with welds; see column 3, lines 34-51. This process would result in the same structure as stent cut from a tube as claimed.

Alternatively, the resulting structure of Lindenberg would be substantially identical to that claimed such that it would have been considered clearly obvious in view thereof to an ordinary artisan; see MPEP 2113, which is incorporated herein by reference thereto.

Regarding claim 47, no two annular elements are exactly alike due to machine tolerances that inherently result in at least slight differences. For this reason, even the end annular elements would inherently have slightly different flexibilities as compared to each other. For this reason, the claim language is fully met.

Claims 34, 35, 37, 42-45, and 47-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Limon et al (US 6,027,526). Limon anticipates the claim language where each of the plurality of annular elements (see Figures 2-4) has a compressed and expanded state (see column 5, lines 1-12 and column 2, lines 10-15) as claimed. The tapered configuration as claimed is a radial taper of the outer diameter; see Figures 15 to 18, column 3, lines 2-7 and column 2, lines 16-31. The ends with different flexibilities are described in different terms as being "stronger towards one end to resist

collapse", which is the different way of saying that the one end is less flexible; see column 3, lines 2-7. Finally, the stent is made from a tube; see column 8, lines 3-9.

With regard to claims 37, 45, and 47, Applicant is directed to see Figure 18.

With regard to claim 48, Applicant is directed to Figure 13 where a tapered ends of the stent are shown such that a tapered flow path would be present therewithin.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Limon (US 6,027,526) in view of Wolff (US 5,104,404) or Pinchasik et al (US 5,449,373) or Orth et al (US 5,591,197). Limon meets the claim language as explained supra, but fails to clearly disclose a connector with a bent region as claimed. However, Wolff (see Figure 3), Pinchasik (see Figures 2A-2C and 3A-3C), or Orth (see Figures 6 and 6A) each teach that it was known to make similar annular element stents with bent connectors. Therefore, it is the Examiner's position that it would have been prima facie obvious to make the connector(s) of Limon bent for the same reasons that the prior art does the same or to give the connectors greater flexibility at the bending points.

Response to Arguments

Applicant's arguments filed August 29, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., tapered configuration and different flexibilities) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). Since the claim language does not state that the diameter is tapered and that the ends have different flexibilities compared to each other, these features have not been read into the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.


Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul B. Prebille
Primary Examiner